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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------------|
| 09/787,497 | 03/16/2001 | Andrew A. Goldfine | A351.12-0002 | 3946 |
| 164 | 7590 | 01/11/2005 | EXAMINER | |
| KINNEY & LANGE, P.A. THE KINNEY & LANGE BUILDING 312 SOUTH THIRD STREET MINNEAPOLIS, MN 55415-1002 | | | | WATKINS III, WILLIAM P |
| | | ART UNIT | | PAPER NUMBER |
| | | 1772 | | |

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/787,497 | GOLDFINE, ANDREW A. | |
| | Examiner William P. Watkins III | Art Unit 1772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 37-52 and 74-100 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 37-52, 76, 79-84, 90-92 and 98-100 is/are allowed.
- 6) Claim(s) 74-75, 77-78, 85-88, and 93-96 is/are rejected.
- 7) Claim(s) 89 and 97 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The rejection of claims 74 and 77 under 35 U.S.C. 102(b) and claims 37-41, 42-43 and 46-50 under 35 U.S.C. 103(a) using Nakayama are withdrawn in view of applicant's arguments that the net structure of Nakayama is rigid.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 74, 77, 85-86 and 93-94 are rejected under 35 U.S.C. 102(b) as being anticipated by Spertus (U.S. 3,546,055).

See Figures 1 and column 3, lines 15-25 of Spertus. The examiner takes the case of the threads abutting as forming a netting structure. The material of the net structure maybe a wire or twine, which is a different material than the foam of the impact members, which are attached to the net structure.

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4. The rejection of claim 47 under 35 U.S.C. 112 is withdrawn in view of applicant's arguments in the paper filed 20 October 2004, that the specification defines voids as not including the cells of a foam.

5. Claims 75, 78, 88-87 and 95-96 are rejected under 35 U.S.C. 102(b) as being anticipated by Habib (U.S. 3,285,768) or Bethe (U.S. 3,961,001).

See Figure 4 of Habib and Figure 5 of Bethe. The examiner takes the projections as being attached to the fabric and in contact with each other.

6. The rejections using Ambrose under 35 U.S.C. 102 are withdrawn in view of applicant's arguments that the limitation of a plurality of first mold cavity portions, and the limitation of the flexible layer being placed between the plurality of first mold cavity portions and the second mold cavity portion, are not shown by the reference.

7. The rejections using Ambrose and Brunner under 35 U.S.C. 103 are withdrawn in view of applicant's argument that the

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reinforcement net of Ambrose teaches away from the flexibility required by Brunner.

8. The rejections using Ambrose and Spertus under 35 U.S.C. 103 are withdrawn in view of applicant's arguments that there is no motivation to mold discrete spheres in Ambrose and no motivation to mold the spheres of Spertus onto to net of Spertus and thus no motivation to combine the references.

9. Claims 37-52, 76, 90-92, 79, 80-84 and 98-100 are allowed due to the withdrawal of the above noted rejections for the reasons given. The examiner notes regarding claims 76 and 79 that newly cited Davidson, Jr. (U.S. 5,160,785) is closer than the previously applied art, but does not show either the top or bottom impact elements being in contact.

10. Claims 89 and 97 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There is no teaching of an open meshed fabric or net in either Habib or Bethe nor motivation to substitute such an open meshed fabric or net.

11. Applicant's arguments, filed 20 October 2004, with respect to claim 74 and 77 and 75 and 78 have been considered but are not persuasive.

Regarding the rejection of claims 74 and 77 by Spertus, applicant argues that the strands of the net do not constitute a net because they are not taught as being joined even though they may be adjacent. Applicant cites and provides a copy of a definition of "net" from a Merriam-Webster's dictionary that defines net as an "open meshed fabric that is twisted, knotted or woven together at regular intervals" and then argues that Spertus does not teach such a net because the strands are not joined. The examiner's stated construction in the rejection is that the crossed strand structure is considered to be a net. The position of the examiner is that this is a reasonable broad construction that is supported by the third sense of the definition cited by applicant, which says a net is "something resembling a net in reticulation". Reticulation being something "resembling or forming a network" (Webster's II New Riverside

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University Dictionary, 1984). The position of the examiner is that the network of crossed strands that abut, resemble a net in reticulation and thus meet the definition of the third sense of the definition of "net" cited by applicant and thus meet the limitation of a net in claims 74 and 77.

Regarding the rejections of claims 75 and 78 by Habib or Bethe, applicant argues that the projections of Habib and Bethe stop when they reach the bottom portion of the projections, that touches and is integral with the bottom portion of adjacent projections, and also that contacts and joins the projection to the flexible substrate, and that therefore the projections do not contact each other or the flexible substrate. The position of the examiner is that this is too narrow a construction of the reference and the claims. The claims call for "impact absorbing members" and are not limited to members which sit on a flat surface and project from that flat surface as argued by applicant. The bottom portion of the foam projections of the references that is in contact with the flexible substrate and the adjacent projections is a foam material that absorbs impacts that impinge on the upper portion of the projecting member because it is integral with that projecting portion. Since it functions to absorb impact with and is integral with the upper

projecting portion, the examiner takes it as being part of the "impact absorbing member" that is a limitation of the instant claims. Applicant's claim language does not exclude such a construction.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art is cumulative to that used in the rejections showing impact projections connected to each other on a flexible substrate.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 703-308-2420. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



WILLIAM P. WATKINS III
PRIMARY EXAMINER

WW/ww

January 8, 2005